

## **REMARKS**

In response to the final Office Action dated July 9, 2008, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1-28 and 31-37 are pending in this application. Claims 29-30 and 38-50 have been canceled without prejudice or disclaimer.

### **Rejection under § 112**

The Office rejected claims 1-28 and 31-37 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. “To comply with the written description requirement ..., each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure.” Department of Commerce, Manual of Patent Examining Procedure § 2163 (II) (3) (b) (hereinafter “M.P.E.P.”). The Office, in particular, alleges that some claimed features fail to find support in the as-filed specification.

The independent claims, however, are fully supported. Support for the claimed feature “*collecting subscriber content-choice data ... describing ... a type of a service provider that provides the content chosen by the subscriber, and a name of the service provider providing the subscriber’s chosen content*” may be found at least at column 2, lines 40-60 of U.S. Application 09/496,825 (Attorney Docket 95003 CON), which is incorporated by reference (disclosing “events” and “event records”). Support may also be found at least at paragraph [0021] (disclosing “the subscriber content-choice data may include, for example, ... subscriber system names (e.g., cable system names)”) and at paragraph [0048] (disclosing that the “data relating to subscriber system include the service provider type (Provider\_Type) and provider name (Provider\_Name)”).

The Office is respectfully requested to reconsider their assertions. While incorporation by reference is permissible, the Office asserts that incorporated matter “must be disclosed in its

entirety within one of the references.” This assertion is not required by 37 C.F.R. § 1.57. Incorporation by reference is permissible, even with “essential material,” as long as the incorporated material is not itself incorporated by reference. *See* 37 C.F.R. § 1.57 (c). So the Office is respectfully requested to reconsider their assertion.

### **Rejection of Claims under § 103 (a)**

The Office rejects claims 1-8, 10-22, 24-28, and 31-36 under 35 U.S.C. § 103 (a) as being obvious over Published U.S. Patent Application 2003/0172374 to Vinson, *et al.* in view of WO 98/31114 to Grauch, *et al.*

These claims, however, are not obvious over the combined teaching of *Vinson* with *Grauch*. These claims recite, or incorporate, features that are not taught or suggested by *Vinson* with *Grauch*. Independent claim 1, for example, recites “*storing the subscriber content-choice data in a database that stores television program data and Internet program data.*” Support may be found at least at paragraphs [0021] and [0044] of the as-filed application. Independent claim 1 is reproduced below, and independent claims 15 and 36 recite similar features.

1. A method for receiving subscriber content-choice information, comprising:

- collecting subscriber content-choice data from a plurality of service providers, each service provider collecting the subscriber content-choice data from their respective subscribers, each subscriber’s content-choice data related to a subscriber’s viewing preferences for content, and each subscriber’s content-choice data describing an event record comprising a command of interest from the subscriber, a time associated with the command of interest, a type of a service provider that provides the content chosen by the subscriber, and a name of the service provider providing the subscriber’s chosen content;
- storing the subscriber content-choice data in a database that stores television program data and Internet program data;
- receiving a request for the subscriber content-choice data, the request specifying the type of the service provider;
- querying for the subscriber content-choice data associated with the type of the service provider; and

responding to the request with the subscriber content-choice data and with the event timeline.

*Vinson* with *Grauch* do not obviate all these features. *Vinson* describes a database that stores set-top box events. See Published U.S. Patent Application 2003/0172374 to *Vinson* at paragraph [0027]. Each set-top box's viewing habits may be correlated to demographic data, news, weather, and sales. See *id.* at paragraphs [0032] and [0033]. A "Data Center" may store the collected data. See *id.* at paragraph [0087]. Users may query the data center and extract "meaningful" information. See *id.* at paragraph [0088]. "Once a target demographic is identified," one or more cable, Internet, or satellite service providers may be chosen. *Id.* at paragraph [0319]. As *Vinson* explains, the capabilities of the service provider may determine different behaviors. *Id.* at paragraph [0319]. *Grauch* collects events and generates timelines. See U.S. Application 09/496,825 at column 2, lines 40-60 of (Attorney Docket 95003 CON), which is incorporated by reference. Even so, the combined teaching of *Vinson* with *Grauch* fails to obviate "storing the subscriber content-choice data in a database that stores television program data and Internet program data," as the independent claims recite. One of ordinary skill in the art, then, would not think that independent claims 1, 15, and 36 are obvious.

Claims 1-8, 10-22, 24-28, and 31-36, then, are not obvious over *Vinson* with *Grauch*. Independent claims 1, 15, and 36 recite many features that are not taught or suggested by *Vinson* with *Grauch*. The dependent claims incorporate these same features and recite additional features. Claims 1-8, 10-22, 24-28, and 31-36, then, are not obvious, so the Office is respectfully requested to remove the § 103 (a) rejection of these claims.

#### **Rejection of Claims 9, 23 & 37 under § 103 (a)**

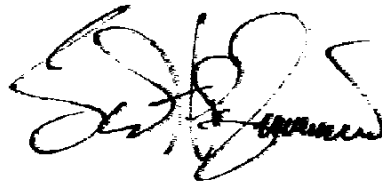
The Office also rejected claims 9, 23, and 37 under 35 U.S.C. § 103 (a) as being obvious over *Vinson* with *Grauch* in view of Published U.S. Patent Application 2002/0123928 to Eldering, *et al.*

Claims 9, 23, and 37, though, cannot be obvious over *Vinson*, *Grauch*, and *Eldering*. These claims depend, respectively, from independent claims 1, 15, and 36 and, thus, incorporate the same distinguishing features. As the above paragraphs explained, both *Vinson* and *Grauch* fail to teach or suggest all the features of independent claims 1, 15, and 36, and *Eldering* does not cure these deficiencies. The Office alleges that *Eldering* discloses storing profile data as XML files. Whether or not this allegation is true, the proposed combination of *Vinson*, *Grauch*, and *Eldering* still fails to teach or suggest all the features of independent claims 1, 15, and 36, from which claims 9, 23, and 37 depend. One of ordinary skill in the art, then, would not think that claims 9, 23, and 37 are obvious. The Office is respectfully requested to remove the § 103 (a) rejection of these claims.

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If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized, cursive script.

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